

PATENT COOPERATION TREATY  
**PCT**  
INTERNATIONAL PRELIMINARY EXAMINATION REPORT  
(PCT Article 36 and Rule 70)

REC'D 03 AUG 1999

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Applicant's or agent's file reference 82064	<b>FOR FURTHER ACTION</b>	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416).
International application No. <b>PCT/AU 98/00813</b>	International filing date (day/month/year) 25 September 1998	Priority Date (day/month/year) 25 September 1997
International Patent Classification (IPC) or national classification and IPC  <b>Int. Cl.<sup>6</sup> G01N 1/08, 1/04, 35/10, G06F 19/00, B26D 5/34, 7/18</b>		
Applicant <b>MACQUARIE RESEARCH LTD et al.</b>		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.  
☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheet(s).

3. This report contains indications relating to the following items:

- |      |                                     |   |
|------|-------------------------------------|---|
| I    | <input checked="" type="checkbox"/> | Basis of the report   |
| II   | <input type="checkbox"/>            | Priority  |
| III  | <input type="checkbox"/>            | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| IV   | <input checked="" type="checkbox"/> | Lack of unity of invention  |
| V    | <input checked="" type="checkbox"/> | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| VI   | <input type="checkbox"/>            | Certain documents cited   |
| VII  | <input type="checkbox"/>            | Certain defects in the international application  |
| VIII | <input checked="" type="checkbox"/> | Certain observations on the international application   |

Date of submission of the demand 14 April 1999	Date of completion of the report 20 July 1999
Name and mailing address of the IPEA/AU AUSTRALIAN PATENT OFFICE PO BOX 200 WODEN ACT 2606 AUSTRALIA Facsimile No. (02) 6285 3929	Authorized Officer  <b>STEPHEN CLARK</b> Telephone No. (02) 6283 2164

**I. Basis of the report****1. With regard to the elements of the international application:\***

- ☒ the international application as originally filed.
- ☐ the description,        pages , as originally filed,  
                                 pages , filed with the demand,  
                                 pages , filed with the letter of .
- ☐ the claims,        pages , as originally filed,  
                                 pages , as amended (together with any statement) under Article 19,  
                                 pages , filed with the demand,  
                                 pages , filed with the letter of .
- ☐ the drawings,        pages , as originally filed,  
                                 pages , filed with the demand,  
                                 pages , filed with the letter of .
- ☐ the sequence listing part of the description:  
                                 pages , as originally filed  
                                 pages , filed with the demand  
                                 pages , filed with the letter of

**2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.**  
These elements were available or furnished to this Authority in the following language which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

**3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, was on the basis of the sequence listing:**

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

**4. ☐ The amendments have resulted in the cancellation of:**

- ☐ the description,        pages
- ☐ the claims,        Nos.
- ☐ the drawings,        sheets/fig

**5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\***

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report

**IV. Lack of unity of invention**

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☒ not complied with for the following reasons:

Claims 1-5 are directed to the excision of a sample by recording an electronic image and using this to move a cutting tool.

Claims 6-12 are directed to a specific cutting tool that may be used in the method or apparatus of claims 1-5.

The cutting tool of claims 6-12 is suitable for, but not specifically used in, claims 1-5. These claims have no novel elements in common with those of claims 1-5 and therefore do not define the same invention.

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
- ☐ the parts relating to claims Nos.

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims 1-12	YES
	Claims	NO
Inventive step (IS)	Claims 1-12	YES
	Claims	NO
Industrial applicability (IA)	Claims 1-12	YES
	Claims	NO

**2. Citations and explanations (Rule 70.7)****NOVELTY (N), INVENTIVE STEP (IS), INDUSTRIAL APPLICABILITY (IA)**

None of the citations alone, or in combination, disclose all of the features of any of the claims.

In particular, the recording of an image position and using the image to control a cutting tool to then excise a sample, retain and deposit it is not known.

Position control by image is known but no citation directed to excising a sample in an array was found.

The specific cutting tool, using an ejector pin that is magnetically controlled to expel a sample, was not found either.

The invention is regarded as being industrially applicable.

**VIII. Certain observations on the international application**

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claim 1 at part (c) is not clear as the phrase seems to require the first "and" be repositioned.